

Applicant submits that the broadest reasonable interpretation of “service mark,” in light of the claims and specification, is: “a mark, in the trademark sense, that is capable of, and that performs the function of, identifying a unique source and that is used to identify a unique source.”

Section 45 of the Lanham Act defines “trademark” and service mark” essentially to include:

any word, name, symbol, or device, or any combination thereof ... used by a person ... to identify and distinguish his or her goods [or services] ... from those manufactured or sold [or provided] by others and to indicate the source of the goods [or services], even if that source is unknown.

A business person of ordinary skill in the art should understand the meaning of service mark as defined by the Lanham Act.

The specification refers to “mark” in four places: (1) original claim 1; (2) in paragraph 15; (3) in paragraph 16; and (4) in paragraph 129. (1) Original claim 1 recites “being identified as Category Directory Websites participating in the System by at least a mark...”. (2) Paragraph 15 speaks of the deficiencies of the prior art and recites that in the prior art, “the user cannot, by reference to an identifying mark or URL, have any reasonable expectation of uniformity of content, organization, comprehensiveness and/or up-to-dateness.” (3) Paragraph 16 discusses the instant invention and recites: “the System [instant invention] includes identification of the CDW’s by some mark, preferably a portion of a URL, ...” (4) Paragraph 129 recites, in discussing the value of a System Manager: “the System Manager may manage and supervise identifying marks or URL’s for the System.” The specification as well as the claims indicate to the ordinary skilled artisan that the function of the “mark” is like that of McDonald’s golden arches, to indicate association with a common unique source and thus to support a reasonable expectation of uniformity of quality.

Applicant submits that based on the proper broadest reasonable interpretation of “service mark,” in the context of the claims and the specification, all claims are allowable. The Examiner does not assert that the “service mark” element, as interpreted by applicant, is disclosed in the references or prior art.

(Secondarily, Applicant submits as a matter of fact that “buy-online” is not a “URL portion” but is rather a term selected by Pricewatch to function as a link to a service offered elsewhere.)

Secondary Issues

1) Expanding Yahoo’s directory listing of a plurality of lower level directories to hundreds or thousands of uniformly organized lower level directories, requires more than routine skill in the art. It requires System structure, with appropriate incentives to call the proper hundreds or thousands into

existence. Applicant teaches such System structure and incentives; see ¶¶ 27-60 of the specification. The Examiner references no such structure and teachings of incentive from the prior art or documented general knowledge. Yahoo references lower level directories that happen to exist. There is no assertion of uniformity among the lower level directories. No structure is taught to bring hundreds or thousands of uniform lower level directories into being.

Applicant submits an inability to understand the Examiner's assertion, page 17, lines 8-12 of the first paragraph that begins on that page:

“the Yahoo engine which constructs the list [of plurality of existing lower level directories] is simply duplicating the working parts and since its duplication has been done a plurality of times it is even more evident that duplication can be done into the hundreds, supported by *St. Regis Paper Company v. Burness Co.*, 193 USPQ8.”

Applicant cannot respond to the quote. The quote together with the rest of the paragraph may assume that hundreds or thousands of proper lower level directories exist and that the Yahoo engine just got tired and stopped finding them. Such assertion is not supported by any documentation. Applicant traverses the assertion.

(2) “Up-to-dateness” involves not only appreciating its value for an Internet Directory System but also providing motivation for its existence. As disclosed in the specification ¶¶ 3, 5, 7, 9, the prior art failed in this respect. Even if Lee were viewed as teaching the value of up-to-dateness for an Internet Directory System, Lee teaches no structure or incentive system (as does the instant specification) to effect such. The prior art of Internet Directory Systems failed here. See spec. ¶¶ 13, 14. If it were “simply prudent” for a website to be up-to-date, then one should not find any websites that are not up-to-date. Common knowledge, as well as the instant specification, discloses that many websites are not up to date. Stale, out-of-date websites are a plague of the internet.

(3) Providing “technical support” to Pricewatch's advertisers is not the same as requiring a standard of operation for lower level directories including professional management. A person of ordinary skill in the art would not equate tech support, provided by a CDW, to professional management, provided by a website. Applicant traverses the general assertion that a business cannot run for at least a year without inherently having professional management. The assertion is not documented or supported by evidence. Applicant believes the evidence would show otherwise.


(4) Applicant submits that the Examiner fails to show that either Pricewatch or Yahoo teach comprehensiveness of lower level directories, comprehensively referencing websites without charge by lower level directories, and/or a contractual relationship between an upper level directory (Yahoo) and a lower level directory (Pricewatch). Applicant also submits that the Examiner does not show remitting

value to the upper level directory provider (Yahoo) in the references or in common knowledge. (On page 19 carryover paragraph, the Examiner admits that Pricewatch, the lower level directory, does not comprehensively reference websites without charge, while Yahoo, the upper level directory, does not charge lower level directories for listing. This is the opposite of applicant's claims. The Examiner does not explain how the combination of references that teaches away from applicant's claims can be seen to teach the claims. The argument at the end of the carry-over paragraph on page 19 appears to reverse the roles of the upper level directory and the lower level directory in the references.)

(5) To the extent the Examiner is arguing a selective combination of references, Examiner should provide reasoning with logical underpinning as to exactly why the Examiner's particular combination would be selected, rather than another combination. The motivation cannot be based on hindsight. Applicant begins the specification chronicling the attempts and the failure of the prior art to create a proper Internet Directory System. The Examiner's motivation should deal with those documented failures.

Respectfully Submitted,

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